

## **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed February 23, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 102(e)**

Claims 22-26, 29-37, 42, 43, and 45-47 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Goshey, et al. ("Goshey," U.S. Pat. No. 6,327,613). Applicant respectfully traverses this rejection.

In the present case, not every feature of the claimed invention is represented in the Goshey reference. Applicant discusses the Goshey reference and Applicant's claims in the following.

#### **A. The Goshey Disclosure**

Goshey discloses a method and apparatus for sharing peripheral devices over a network. Goshey, Patent Title. As is described by Goshey, a system is envisioned in which a plurality of computers (e.g., 112a, 112b, and 112d) connected to a network 110 comprise external peripheral devices that are directly connected thereto. Goshey, column 4, lines 31-36. Each of the computers 112 is provided with software code that enables other computers connected to the network to use the peripheral devices that are connected to the computers. Goshey, column 4, line 67 to column 5, line 5. In this manner, a first computer (e.g., 112d) may access and use a peripheral device directly connected to a second computer (e.g., 112b).

A specific example of the above functionality is provided in column 5. As is described by Goshey:

By way of example, if the Server (S) ScanLAN code is loaded onto computer 112b, and the Client (C) ScanLAN code is loaded onto computer 112d, then the user of computer 112d may be granted access privileges to the peripheral devices connected to computer 112b (which runs as a Server). Alternatively, each one of computers 112b and 112d may be loaded with both the Server and the Client ScanLAN code, which will therefore enable other users connected to the network to access the peripheral devices connected to both computer 112b and computer 112d, when they are running as a Server.

[Goshey, column 5, lines 25-35]

From the above, it is clear that Goshey provides a system in which remote peripheral devices may be accessed and used *if* they are connected to a computer that is connected to the network and that comprises Goshey's "ScanLan" code.

## **B. Applicant's Claims**

As is noted above, Goshey fails to teach several of Applicant's claim limitations. Applicant discusses some of those claim limitations in the following.

**1. Claims 22-26, 29-31**

Applicant's claim 22 provides as follows (emphasis added):

22. A method, comprising:

*discovering devices directly connected to a network that are not directly connected to a computer; and*

providing to a user via a network browser a list of at least one device that is available for use on the network, wherein the list comprises at least one link to an available device.

Applicant notes that, as is described above, Goshey's system is described, and only described, as facilitating access to peripheral devices that are directly connected to a computer that comprises "ScanLan" code that enables peripheral device sharing. Accordingly, Goshey does not teach a method comprising "*discovering devices directly connected to a network that are not directly connected to a computer*", as is now recited in claim 22.

At least in view of the above, Applicant respectfully submits that Goshey does not anticipate claim 22, or the claims that depend therefrom. Applicant therefore respectfully requests that the rejections against these claims be withdrawn.

With specific regard to the claims that depend from claim 22, Applicant asserts that those claims contain additional limitations that are not taught by Goshey.

## 2. Claims 32-37

Applicant's claim 32 provides as follows (emphasis added):

32. A device discovery service stored on a computer-readable medium, the service comprising:

*logic configured to discover devices directly connected to a network that are not directly connected to a computer;* and

logic configured to provide a user home service accessible with a network browser with a list of at least one device that is available for use on the network.

Regarding claim 32, Goshey at least does not teach "logic configured to discover devices *directly connected to a network that are not directly connected to a computer*", at least for reasons discussed in relation to claim 22. Applicant respectfully submits that Goshey therefore does not anticipate claim 32 and its dependents, and respectfully requests that the rejections against these claims be withdrawn.

With specific regard to the claims that depend from claim 32, Applicant asserts that those claims contain additional limitations that are not taught by Goshey.

## 3. Claims 42, 43, and 45-47

Applicant's claim 42 provides as follows (emphasis added):

42. A system, comprising:

*means for discovering devices directly connected to a network that are not directly connected to a computer;*

means for querying the means for discovering to receive a list of discovered devices;

means for creating links to the discovered devices; and

means for providing the links to a user in a network browser for selection.

Regarding claim 42, Goshey does not teach “means for discovering devices *directly connected to a network that are not directly connected to a computer*”, at least for reasons discussed in relation to claim 22. Applicant respectfully submits that Goshey therefore does not anticipate claim 42 and its dependents, and respectfully requests that the rejections against these claims be withdrawn.

With specific regard to the claims that depend from claim 42, Applicant asserts that those claims contain additional limitations that are not taught by Goshey.

### C. Conclusion

Due to the shortcomings of the Goshey reference described in the foregoing, Applicant respectfully asserts that Goshey does not anticipate Applicant’s claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

### II. Claim Rejections - 35 U.S.C. § 103(a)

Claims 27, 28, 38, 39, 40, 41, and 44 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Goshey in view of Carcerano, et al. (“Carcerano,” U.S. Pat. No. 6,308,205). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant’s disclosure.

In the present case, the prior art at least does not teach or suggest all of the claim limitations.

As is identified above, Goshey does not teach explicit limitations of Applicant’s claims. In that Carcerano does not remedy the deficiencies of the Goshey reference, Applicant respectfully submits that claims 27, 28, 38-41, and 44 are allowable over the Goshey/Carcerano combination for at least the same reasons that Applicant’s other claims are allowable over Goshey.

### **III. Comments Regarding Examiner's "Response to Arguments"**

In the Office Action, the Examiner states that Applicant's arguments from the previous Response are "not persuasive." The Examiner addresses two of those arguments in the Response to Arguments section of the final Office Action. Applicant provides comments as to the Examiner's points in the following.

#### **A. Goshey's Failure to Teach "Discovering Devices Directly Connected to a Network that are Not Directly Connected to a Computer"**

The Examiner first argues that Applicant is incorrect in stating that Goshey fails to teach discovering devices "directly connected to a network" that are not "directly connected to a computer". For support, the Examiner states the following:

Column 5, lines 8-24, Goshey discloses users of a selected networked computer will then be able to access the peripheral devices connected to other network computers *as if* the peripheral devices were connected to their local computer.

Office Action, page 14 (emphasis added). Applicant sees nothing in the above statement that refutes the fact that Goshey does not teach discovering devices directly connected to a network that are not directly connected to a computer. Although, due to software provided on a computer that is directly connected to the peripheral device, a remote user can access the peripheral device "as if" it were connected to his computer, this still does not mean that the peripheral device is not in reality directly connected to a computer. To the contrary, the

peripheral device identified by the Examiner *actually is* directly connected to a computer. Moreover, such an arrangement is *required* in the Goshey system because the only reason the remote user can access the peripheral device in the first place is due to the “ScanLan” software that runs on the computer to which the peripheral device is directly connected. Therefore, not only does Goshey’s system comprise peripheral devices directly connected to computers, that system cannot provide the functionality desired by Goshey if the peripheral devices were not so directly connected to the computer.

Next, the Examiner states that “[i]n figure 2C, it is clear that computer peripheral devices 118, 120 and 121 directly connected [*sic*] to the network.” Office Action, pages 14-15. This is clearly untrue. Figure 2C shows the *opposite* of what the Examiner asserts. Instead, Figure 2C shows each of peripheral devices 118, 120, and 121 only connected to the network *via a computer 112b and its host adapter 116b*. Nowhere in Figure 2C is a peripheral device directly connected to the network, which is clearly identified by a cloud containing the term “NETWORK.”

Finally, the Examiner attempts to argue that because networks comprise routers, modems, etc., Goshey can be said to teach peripheral devices “connected to the network” but not directly connected to a computer. Applicant notes that this point is irrelevant. Again, Applicant claims discovering devices “directly connected” to a network. Goshey clearly does not teach such an arrangement. Goshey *only* discloses and illustrates peripheral devices that connect to a network *through a host computer*. Once again, those computers are *required* in the Goshey system because they contain the software that is required to access the peripheral devices from remote computers, which is the point of the Goshey disclosure.

**B. Carcerano's Failure to Remedy the Deficiencies of the Goshey Reference**

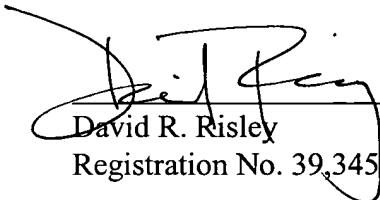
The Examiner also disagrees with Applicant as to Carcerano's failure to remedy the deficiencies of the Goshey reference.

In response, Applicant notes that, as described above, Goshey at least fails to teach "discovering devices directly connected to a network that are not directly connected to a computer". Applicant further notes that nowhere does the Examiner state that Carcerano teaches such discovering. Accordingly, neither reference provides the missing teaching and the rejection does not make a *prima facie* case of obviousness under 35 U.S.C. § 103 for failure to teach or suggest all of the claim limitations.

## CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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4-11-06

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Signature